

REMARKS

Applicants respectfully requests entry of the amendments and remarks submitted herein. Claims 16, 21, 23 and 24 have been amended herein, and claims 17, 22, 25 and 26 have been canceled without prejudice to continued prosecution.

Claims 1-4, 16, 19-21, 23 and 24 are currently pending. Reconsideration of the pending application is respectfully requested.

The 35 U.S.C. §102 Rejections

Claims 16 and 21 stand rejected under 35 U.S.C. §102(b) as being anticipated by prior art admitted by Applicant in the specification. According to the Examiner, page 3 of the specification discloses that *S. persica* sticks are known products. The Examiner asserted that chewing the products would produce a *S. persica* extract, and that the recitation of the intended use must result in a structural difference between the claimed invention and the prior art in order for the claimed invention to be novel. It is noted that claim 16 has been amended herein to clarify that the chewable or ingestible product for companion animals includes collagenous chewables, food, treats or snacks, or toys, while claim 21 has been amended herein to clarify that the oral hygiene product for companion animals can be a toothbrush, toothpaste or a medicament. This rejection is respectfully traversed with respect to the pending claims.

Applicant's specification discloses the long history of *S. persica* sticks by humans, Applicant does not admit and has never admitted that products such as chewables, food, treats, snacks, toys, toothbrushes, toothpaste or medicaments containing a *S. persica* extract have been made and/or used in the prior art. In fact, Applicant can find no disclosure in the prior art regarding any type of chewable, food, treat or snack, or chew toy that contains *S. persica* extract (claim 16), nor can Applicant find any disclosure in the prior art regarding the claimed toothbrush, toothpaste or medicament that contains a *S. persica* extract (claim 21). There are no admissions in the instant specification that anticipate the compositions of pending claim 16 or 21, and Applicant respectfully requests that the rejection of claims 16 and 21 under 35 U.S.C. §102(b) be withdrawn.

Claims 16, 21 and 26 stand rejected under 35 U.S.C. §102(b) as being anticipated by Almas et al. (*Biomed. Lett.*, 1999, 60:71-75). The Examiner asserted that the 1999 Almas et al. reference teaches that *S. persica* sticks have antibacterial properties and are used to clean the teeth. As indicated above, claims 16 and 21 have been amended herein to clarify that the products for companion animals can be chewables, food, treats, snacks, toys, toothbrushes, toothpaste or medicaments containing *S. persica* extract. Applicant has canceled claim 26 without prejudice to continued prosecution. This rejection is respectfully traversed with respect to the pending claims.

The 1999 Almas et al. reference discloses a similar history of *S. persica* as that disclosed in Applicant's specification, and the research and results portion of Almas et al. is directed toward a comparison of the anti-microbial effects of *S. persica* bark extract vs. pulp extract vs. whole plant extract. There is no teaching or suggestion in the 1999 Almas et al. reference that an *S. persica* extract can be used in products such as chewables, food, treats or snacks, toys, toothbrush, toothpaste or medicament. The 1999 Almas et al. reference does not anticipate pending claims 16 and 21, and Applicant respectfully requests that the rejection of pending claims 16 and 21 under 35 U.S.C. §102(b) be withdrawn.

Claims 16, 20-23, 25, and 26 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ahmad et al. (U.S. Patent No. 5,009,886). According to the Examiner, Ahmad et al. teaches using a *S. persica* extract to make rinses and toothpastes. As indicated above, independent claims 16 and 21 have been amended herein to clarify that the claimed products are chewables, food, treats, snacks, toys, toothbrushes, toothpaste or medicaments containing *S. persica* extract. Applicant has canceled claims 25 and 26 without prejudice to continued prosecution. This rejection is respectfully traversed with respect to the pending claims.

Contrary to the Examiner, Ahmad et al. is directed toward methods of making and using a paste, a gel, a powder, or a rinse that contains microfibers and/or micro-sized particles of branches and roots of *S. persica*. According to Applicant's specification, microfibers and micro-sized particles of branches and roots are not an extract. See, for example, page 5, line 24 through page 6, line 29 of the specification, which describes extraction as a process "whereby the desired constituents of a plant or plant part are removed using a solvent or other means." The products recited in claims 16 and 21 that contain a *S. persica* extract are not anticipated by Ahmad et al.,

and Applicant respectfully requests that the rejection of pending claims 16 and 20-23 under 35 U.S.C. §102(b) be withdrawn.

The 35 U.S.C. §103 Rejections

Claims 1-4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Almas (*J. Contemp. Dental Practice*, 2002, 3(3):1-10) or Ahmad et al. in view of Sigurdsson (U.S. Patent No. 5,033,410) for the reasons set forth in the previous Office Action. According to the Examiner, the 2002 Almas et al. reference teaches that the *S. persica* sticks have antibacterial properties and are used to clean the teeth, while Sigurdsson teaches flavored chew items for animals to clean their teeth. Ahmad et al. is discussed above and discloses a paste, a gel, a powder, or a rinse that contains microfibers and/or micro-sized particles of branches and roots of *S. persica*. The Examiner asserted that it would be an obvious modification to coat the chewing stick taught by Almas with flavors desirable for animals as taught by Sigurdsson, and also asserted that a person of ordinary skill in the art would reasonably expect that the *S. persica* sticks taught by Ahmad et al. could be used for animals and would be more attractive to the animals if coated with desirable flavors. These rejections are respectfully traversed with respect to the pending claims.

An invention is not obvious merely because the prior art could be modified. *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Instead, the prior art, as a whole, must fairly suggest the desirability to make the patentee's invention. *Id.* The Examiner is reminded that the consistent criterion for an obviousness rejection is that the prior art must suggest the claimed invention. The suggestion must be found in the prior art, not in the Applicant's own disclosure (*In re Dow Chemical Co.*, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988)).

The claims are directed toward *S. persica* sticks containing one or more exogenously added flavors, vitamins, nutrients or medicines. The 2002 Almas reference is directed toward a comparison of different anti-plaque agents (e.g., CHX vs. a miswak extract), while Ahmad et al. is directed toward using microfibers and/or micro-sized particles of branches and roots of *S. persica* in an oral paste, gel, powder, or rinse. Neither the 2002 Almas reference nor Ahmad et al. teaches or suggests that *S. persica* sticks can include exogenously-added flavors, vitamins, nutrients, or medicines. Sigurdsson teaches flavored chew items for animals to clean their teeth, but does not teach or suggest using *S. persica* sticks as the flavored material. None of those

references contains any motivation to combine a flavor or any other compound with *S. persica* sticks. As evidence of the non-obviousness of claims 1-4, Applicant can find no evidence in the more than one thousand year-long history of *S. persica* that exogenous flavors have ever been added.

Given the large amount of literature published on *S. persica*, the lack of prior art directed toward *S. persica* sticks containing an exogenous compound such as a flavor, a vitamin, a medicine, or a nutrient is compelling evidence that the Examiner is using hindsight to construct the obviousness rejection and that the claimed products containing a *S. persica* extract are not obvious. In addition, the Examiner has not met the burden of establishing the motivation required under the obviousness standards. In view of the remarks herein, Applicant respectfully requests that the rejections of claims 1-4 under 35 U.S.C. §103(a) be withdrawn.

Claims 16, 17, and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ahmad et al. (U.S. Patent No. 5,009,886) in view of Fisher et al. (U.S. Patent No. 4,145,447). The Examiner asserted that the product taught by the combination of the references is considered to be structurally the same as the claimed product. As indicated herein, claim 16 has been amended herein to clarify that the chewable or ingestable product for companion animals are chewables, food, treats, snacks, or toys. This rejection is respectfully traversed with respect to the claims as amended herein.

As indicated above, an invention is not obvious merely because the prior art could be modified. *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Instead, the prior art, as a whole, must fairly suggest the desirability to make the patentee's invention. *Id.* The consistent criterion for an obviousness rejection is that the prior art must suggest the claimed invention, and the suggestion may not come from Applicant's own disclosure (*In re Dow Chemical Co.*, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988)).

Ahmad et al. is discussed above, and is directed toward using microfibers and/or micro-sized particles of branches and roots of *S. persica* in an oral paste, gel, powder or rinse. Ahmad et al. contains no teaching or suggestion that a *S. persica* extract can be used in one or more of the claimed collagenous chewables, food, treats or snacks, or toys. Fisher et al. discloses an animal chew made from compacted animal feed, and simply discloses that "any desired vitamins, proteins, food additives, medicines or supplements, minerals, etc., can be added." Adding

vitamins or minerals to products ingested by humans or animals is not a new concept, and Fisher et al. contains no teaching or suggestion that the animal chew can contain a *S. persica* extract.

As the cited references contain no suggestion to make the claimed invention, the Examiner's assertion is based on hindsight. Applicants can find no disclosure in the prior art of using a *S. persica* extract in the claimed products (e.g., collagenous chewables, food, treats or snacks, or toys) for use by humans or companion animals. The Examiner has not met the burden of establishing the motivation required under the obviousness standards. In view of the amendments and remarks herein, Applicant respectfully requests that the rejection of pending claims 16 and 19 under 35 U.S.C. §103(a) be withdrawn.

Claims 21-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ahmad et al. (U.S. Patent No. 5,009,886) for the reasons set forth in the previous Office Action. According to the Examiner, although Ahmad et al. does not teach impregnating the toothbrush bristles with *S. persica*, the beneficial effects on the teeth by *S. persica* provides the reasonable expectation of success for making the products of claim 21. As indicated herein, claim 21 has been amended herein to clarify that the oral hygiene product for companion animals include toothbrushes, toothpaste and medicaments. This rejection is respectfully traversed with respect to the pending claims.

As indicated above, an invention is not obvious merely because the prior art could be modified. *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Instead, the prior art, as a whole, must fairly suggest the desirability to make the patentee's invention. *Id.* The consistent criterion for an obviousness rejection is that the prior art must suggest the claimed invention, and the suggestion may not come from Applicant's own disclosure (*In re Dow Chemical Co.*, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988)).

Ahmad et al. is discussed above, and is directed toward using microfibers and/or micro-sized particles of branches and roots of *S. persica* in an oral paste, gel, powder or rinse. There is no teaching or suggestion in Ahmad et al. for the claimed products coated or impregnated with a *S. persica* extract. As discussed herein, obviousness requires a suggestion or motivation to make the claimed invention, and the suggestion to make the claimed invention is required before a reasonable expectation even can be an issue. The Examiner has not met the burden required under the obviousness standards and, in view of the amendments and remarks herein, Applicant

respectfully requests that the rejection of pending claims 21-24 under 35 U.S.C. §103(a) be withdrawn.

The Double Patenting Rejection

Claims 16-26 are provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending U.S. Application No. 10/872,689 for the reasons set forth in the previous Office Action.

Applicant respectfully resubmits the request that this rejection be held in abeyance until allowable subject matter is found. At that time, Applicant will submit an appropriate Terminal Disclaimer.

CONCLUSION

Applicant respectfully requests allowance of claims 1-4, 16, 19-21, 23 and 24. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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Date: _____

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